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EXAMINER

RODRIGUEZ, RUTH C

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/030,445

Applicant(s)

SCHWARZBICH, JORG

Examiner

Ruth C. Rodriguez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 5, 6, 9, 10, 16, 18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertalot (US 3,887,155) in view of Burke et al. (US 3,757,601).

Bertalot discloses a telescopic mechanism (1,2,3) comprises an internal element (2,3), an external element (1,2) and roll barrels (18). The internal element has a flattening at least on one side (Figs. 1-3). The external element is complementary to the internal element (Figs. 1-3). The roll barrels guide the internal element in the external element, the roll barrels roll at the flattening (Figs. 1-3) and at least some of the roll barrels are constructed as hollow bodies (Fig. 4). Bertalot fails to disclose that the hollow bodies are elastically deformable. However, Burke teaches a telescopic mechanism (48,66,70) comprises an internal element (70), an external element (66) and roll barrels (84). The external element is complementary to the internal element (Figs. 1-3). The roll barrels guide the internal element in the external element (Figs. 1-3) and at least some of the roll barrels are constructed as hollow elasticity bodies that are elastically deformable (C. 3, L. 23-25). The hollow elasticity bodies provide the convenience of always covering the gap between the internal element and the external

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element due to its natural resiliency (C. 3, L. 25-47). Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to have at least some of the roll barrels constructed as hollow elastic bodies that are elastically deformable in accordance the teachings of Burke in the telescopic mechanism disclosed by Bertalot. Doing so, will always cover the gap between the internal element and the external element due to the natural resiliency of the hollow barrels.

Burke also teaches that:

The hollow bodies are hollow cylinders (C. 3, L. 25-33).

The hollow cylinders are formed by a rolled-up blank such that the ends of the blank abut one another with formation of a seam (C. 3, L. 25-33 and Figs. 5).

Bertalot also discloses that:

The internal element has a polygonal external cross section and forms several flattenings that support in each case a set of the hollow bodies at a corresponding flattening of an inner cross section of the external element (Figs. 1-3).

The telescopic mechanism further comprises a cage (12,13,14,15) that holds the hollow bodies and fills a space between the internal element and the external element with little clearance and forms a boundary for deformation of an external section of the hollow bodies (Figs. 1-4).

A telescopic mechanism (1,2,3) comprises an internal element (2,3), an external element (1,2) and roll barrels (18). The internal element has a flattening at least on one side (Figs. 1-3). The external element is complementary to the internal element (Figs. 1-3). The internal element and the external element are movable relative to each other

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in an axial direction (C. 1, L. 4-8). The roll barrels guide the internal element in the external element (Figs. 1-3). The roll barrels are oriented substantially transverse to the axial direction of movement between the external element and the internal element (Figs. 1-3). The roll barrels are located at the flattening (Figs. 1-3). At least some of the roll barrels are constructed as hollow bodies (Fig. 4). Bertalot fails to disclose that the hollow bodies are elastically deformable. However, Burke teaches a telescopic mechanism (48,66,70) comprises an internal element (70), an external element (66) and roll barrels (84). The external element is complementary to the internal element (Figs. 1-3). The roll barrels guide the internal element in the external element (Figs. 1-3) and at least some of the roll barrels are constructed as hollow elasticity bodies that are elastically deformable (C. 3, L. 23-25). The hollow elasticity bodies provide the convenience of always covering the gap between the internal element and the external element due to its natural resiliency (C. 3, L. 25-47). Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to have at least some of the roll barrels constructed as hollow elastic bodies that are elastically deformable in accordance the teachings of Burke in the telescopic mechanism disclosed by Bertalot. Doing so, will always cover the gap between the internal element and the external element due to the natural resiliency of the hollow barrels.

3. Claims 1-4, 14, 15, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertalot in view of British Patent Document GB 530,342.

Bertalot discloses a telescopic mechanism (1,2,3) comprises an internal element (2,3), an external element (1,2) and roll barrels (18). The internal element has a

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flattening at least on one side (Figs. 1-3). The external element is complementary to the internal element (Figs. 1-3). The roll barrels guide the internal element in the external element, the roll barrels roll at the flattening (Figs. 1-3) and at least some of the roll barrels are constructed as hollow bodies (Fig. 4). Bertalot fails to disclose that the hollow bodies are elastically deformable. However, British Patent Document GB 530,342 (GB '342) teaches the use of hollow bodies that are elastically deformable as bearings. The hollow bodies used as bearings are very useful because they are flexible and when assuming the oval shape they reduce possible indentations (P. 2, L. 33-38). Therefore, it would have being obvious to one having ordinary skill in the art at the time of applicant's invention to have the hollow bodies that are elastically deformable as taught by GB '342 in the mechanism disclosed by Bertalot. Doing so, provides great flexibility when assuming the oval shape thereby reducing possible indentations while also providing a reduction in the weight (Page 2, L. 16-20).

GB '342 also teaches that:

The hollow barrels are helical springs (Figs. 1-6).

The helical springs are tensile springs having coils that lie against one another on block in an unstressed state (P. 3, L. 25-29).

The helical springs are formed from a spring steel with a rectangular cross section (P. 3, L. 25-29 and Fig. 4).

A solid cylindrical roll (20) that supports the inner surface of the hollow body with clearance limits elastic deformation of an outer cross section of the hollow body and is inserted into at least one of the hollow bodies (Fig. 4).

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Bertalot also discloses that:

The internal element has a polygonal external cross section and forms several flattenings that support in each case a set of the hollow bodies at a corresponding flattening of an inner cross section of the external element (Figs. 1-3).

The telescopic mechanism further comprises a cage (12,13,14,15) that holds the hollow bodies and fills a space between the internal element and the external element with little clearance and forms a boundary for deformation of an external section of the hollow bodies (Figs. 1-4).

4. Claims 7, 8, 13 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Bertalot in view of Burke as applied to claim 6 above, and further in view of Wells (US 1,617,613).

The combination of Bertalot and Burke discloses a telescopic mechanism as described above in paragraph 2 for the rejection of claim 6. Bertalot and Burke fails to disclose that the seam extends obliquely to an axis of the respective hollow cylinder. However, Wells teaches how hollow cylinders (20) can be made of by a rolled-up blank such that the ends of the blank abut one another with formation of a seam extending obliquely to an axis of the respective hollow body. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to have hollow cylinders made of by a rolled-up blank such that the ends of the blank abut one another with formation of a seam that extends obliquely to an axis of the respective hollow body as taught by Wells in the mechanism disclosed by Bertalot and modified by Burke. Doing so, is known in the art as taught by Wells and by providing a seam that

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extends obliquely to an axis of the respective hollow body the natural resiliency of the hollow body will be distributed along the entire oblique extension of the seam instead of being distributed along a straight line seam.

The seam taught by Wells extends around the respective hollow cylinder at least once (Figs. 1-6).

Wells also teaches a solid cylindrical roll (18) that supports the inner surface of the hollow body with clearance limits elastic deformation of an outer cross section of the hollow body and is inserted into at least one of the hollow bodies (Figs. 1 and 2).

5. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertalot in view of Bertalot in view of Burke as applied to claim 10 above, and further in view of Lennon et al. (US 5,345,679).

Bertalot discloses that the cage forms several thickened section that in each case are assigned to a flattening of the internal element and accommodate a set of hollow bodies and are connected with one another by cross members (22). Bertalot fails to disclose that the cross member connecting the thickened sections is flexible. However, Lennon teaches a cage (34) for bearings (32) made from a plastic sleeve blank provided with flexible cross members (60). The flexible cross members made to assure that the cage conforms to the shaped of the between the inner element (18) and the outer element (20) (C. 3, L. 53-51). Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to have the flexible cross members taught by Lennon in the cage disclosed by Bertalot. Doing so, conforms



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the shape of the cage to the shaped of the between the inner element and the outer element.

The cage taught by Lennon is an injection-molded part (C. 2, L. 50-57) that is produced as a stretched tape and is bent at the cross members into a shape corresponding to the external cross section of the internal element (Figs. 1-3F).

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1, 5-13, 16, 18 and 20 have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's arguments filed 21 July 2003 have been fully considered but they are not persuasive.

8. In response to Applicant's argument that the references (GB '342 and Wells) fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the roll barrels are not oriented perpendicular to the axial direction of movement) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). For claim 21 where the Applicant does include this limitation, the Examiner will like to point out that the document by Bertalot does disclose having cylindrical elements used in a direction perpendicular to the axial direction of movement. The references GB '342, Lennon and Wells are only used as teaching references of the use of roll barrels between an internal element and an external element where references are being used

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for its teaching of the construction of the roll barrels and not for the orientation with respect to an axial direction of movement.

9. The Applicant also presents another argument against the combination of Bertalot and GB '342. This argument fails to persuade. Essentially, the Applicant acknowledges that having hollow cylindrical bodies taught by GB '342 will provide a decrease of the weight of the vehicle in which they are being used regardless of whether the vehicle is an aircraft or an automobile. Therefore, providing the hollow cylindrical bodies of GB '342 does provide a weight reduction when used in a vehicle and this weight reduction will yield better gas mileage. Additionally, the Applicant fails to address the motivation of avoiding indentations in the outer element that are caused by the vibration that is also present in an automobile. Finally, the Applicant provides his own motivation for the use of the helical springs as the hollow bodies. In response to applicant's argument that the helical springs are used for an entirely different reason, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is included in Form PTO 892-References cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C. Rodriguez whose telephone number is (703) 308-1881. The examiner can normally be reached on M-F 07:15 - 15:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (703) 306-4115.

Submissions of your responses by facsimile transmission are encouraged. Technology center 3600's facsimile number for before final communications is (703) 872-9326. Technology center 3600's facsimile number for after final communications is (703) 872-9327. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase the patent's term, it is to your

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benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as PTO's mailroom processing and delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see MPEP § 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee that the applicant is paying by check **should not be** submitted by facsimile transmission separately from the check.

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If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP § 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response has been transmitted by facsimile will cause further unnecessary

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delays in the processing of your application, duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Ruth C. Rodriguez  
Patent Examiner  
Art Unit 3677

rcr  
October 2, 2003

  
Anthony Knight  
Supervisory Patent Examiner  
Group 3600